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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,008

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EXAMINER

MISIASZEK, MICHAEL

ART UNIT

PAPER NUMBER

3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,008	Applicant(s) BARNES LEON ET AL.	
	Examiner MICHAEL MISIASZEK	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-8,11-21,24,26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 3,11 and 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8,12-16,24,26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/26/2009 has been entered.

Response to Amendment

Applicant's amendments filed 10/26/2009 have been received and reviewed. The status of the claims is as follows:

Claims 3, 5-8, 11-21, 24, 26, 28, and 29 are pending. Claims 3, 11, and 17-21 were previously withdrawn from consideration.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 5-8, 24, 28, and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 5-8, 24, 28, and 29 are non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 24, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rappoport in view of Young (US 20050160361 A1).

Regarding Claims 24, 26, 28

Rappoport discloses a computer-readable medium carrying one or more sequences of instructions, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform a method in a computing system, the method comprising:

- extracting a first set of product management information in a first form, wherein the first form is associated with a first source computerized product management system (at least abstract: product design data for source system extracted from source system)
- converting the first set of product management information in the first form, wherein the converting the first set of product management information in the first form converts the first set of product management information in the first form into a first set of product management information that is in a second intermediate form (at least column 10, lines 1-8: data converted into intermediate form and stored in a bridge structure)

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- converting the first set of product management information in the second intermediate form, wherein the converting the first set of product management information in the second intermediate form converts the first set of product management information in the second intermediate form into a first set of product management information in a target form, the first set of product management information in the target form corresponds to a target computerized product management system (at least column 5, lines 1-16: intermediary form converted to target form for target system)
- in response to the converting of the first set of product information into the target form, creating a new product record in the target computerized product management system

Rappoport does not explicitly disclose:

- performing the extracting, converting, and converting on a second set of product management information
- in response to the converting the second set of product management information into the target form, performing an update of an existing the new product management record in the target computerized product management system using the second set of product management information in the target form, wherein the existing product management record resided in the target computerized product management system prior to converting the product management information into the target form.

Young teaches that it is known to include repeating a data mapping process on a second set of information and updating existing data records created by a prior operation of a data mapping (at least paragraph 10) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the computer readable medium and method of Rappoport, with the repeating a data mapping process and updating a previously created record, as taught by Young, since such a modification would have provided benefits from improved data transformation, translation, mapping, and/or adaptation systems and methods that facilitate converting data between different formats and increasing interactions between applications (at least paragraph 4 of Young).

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Rappaport further does not specifically disclose that the data being stored and converted in the method is product management information.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The extracting, converting, and performing steps would be performed in the same manner regardless of the data. Merely labeling the data in a specific manner would not alter the functionality of the claimed method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Further, the examiner notes that Rappaport teaches using CAD systems for handling enterprise resource planning data (see at least column 1, lines 43-52), which is equated to product management information in the present specification.

Regarding Claim 29

Rappaport discloses:

- wherein the second intermediate form comprises a plurality of product elements (at least column 10, lines 1-8, column 8, lines 45-61: intermediate form contains product model, which comprises a feature list)

3. Claims 5-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rappoport in view of Young as applied above, and further in view of Walsh.

Rappoport and Young disclose the claimed invention except for an intermediate form that comprises hierarchy of data elements comprising a plurality of product elements. Walsh teaches that it is known to include a hierarchy of enterprise business data elements (at least paragraph [0098] in an environment in which enterprise data is mapped to a new format. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention, as taught by Rappoport, with the hierarchy of data elements, as taught by Walsh, since such a modification would have provided increased effectiveness of an enterprise through use of "best of breed" business processes in combination (at least paragraph 44 of Walsh).

While the combination of Rappoport, Young, and Walsh does disclose various hierarchies of data elements, the combination does not disclose the specific hierarchy of data elements claimed. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The extracting, converting, and performing steps of independent claims 24 and 26 would be performed in the same manner regardless of the data format. In other words, no matter the format or organization of the product management information hierarchy, the same steps would be performed. Merely arranging the data in a specific fashion or labeling the data in a specific manner would not alter the functionality of the claimed method. Thus, this descriptive material will not distinguish the claimed invention from the prior art

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in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform data conversion on any data hierarchy arrangement because such information does not functionally relate to the steps in the method claimed and merely organizing the data hierarchy differently from that in the prior art would have been obvious. See *Gulack* cited above.

Response to Arguments

Applicant's arguments with respect to claims 24, 26, and 28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL MISIASZEK whose telephone number is (571)272-6961. The examiner can normally be reached on 9:00 AM - 5:30 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Misiaszek/
Acting Examiner of Art Unit 3625